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PATENT**REMARKS/ARGUMENTS**

Claims 1-13 and 16 are in this application. Claims 14-15 and 17-20 have been cancelled, and Claims 10 and 12 have been amended, as further discussed below.

Cancellation of Claims

Claims 14-15 and 17-20 have been canceled because they are drawn to nonelected Group I and species A. Applicants reserve the right to pursue these claims in a divisional patent application.

Rejections Under 35 U.S.C. 112

Claims 10-12 have been rejected as indefinite under the 35 U.S.C. 112. Claim 10 has been amended to provide antecedent basis for "the nacelle highlight." This amendment is supported by paragraph [0034] and Figure 2A of the application as filed. Claim 11 is dependent upon Claim 10. Claim 12 has been amended to specify that the claimed sections extend around the circumference at the "inlet lip portion" of the nacelle. This amendment is supported by Claim 1 as originally filed, which recites that the claimed acoustic panel is located at the "inlet lip portion" of the nacelle. In view of the foregoing, it is respectfully submitted that Claims 10-12 fully comply with 35 U.S.C. 112.

Rejections Under 35 U.S.C. 103

Claims 1-9 and 16 have been rejected under 35 U.S.C. 103 as obvious in view of U.S. Patent No. 4,291,079 (Hom) or U.S. Patent No. 5,653,836 (Mnich et al.) in combination with U.S. Patent No. 3,800,121 (Dean et al.). As expressly set forth in independent Claims 1 and 16 of this application (as well as the remaining claims ultimately dependent thereon), the present invention is directed to an acoustic panel and an engine nacelle inlet lip comprising an ice

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protection system which incorporates an acoustically permeable structure. *See, e.g.*, paras. [0010]-[0011], [0029]-[0030] and Figs. 2A, 2B, 4 and 5 of the application as filed.

As acknowledged by the Examiner, Hom and Mnich et al. disclose acoustic panels, but are silent as to incorporation of an ice protection system. *See* Office Action, p. 3. In an attempt to overcome these defects in Hom and Mnich et al., the Examiner asserts that Dean et al. teaches an ice protection system that has an acoustically permeable structure, and that one of ordinary skill in the art would therefore find the claimed invention obvious in view of the combined teachings Hom or Mnich et al. and Dean et al.

However, it is respectfully submitted as a threshold matter that the Examiner has failed to establish the *prima facie* obviousness of Claims 1 and 16. It is axiomatic that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* MPEP § 2143.01 at p. 2100-131 (Rev. 2, May 2004). Moreover, to establish *prima facie* obviousness based upon the assertion that the references relied upon teach that all aspects of the claimed invention were individually known in the art, the Examiner must provide some objective reason to combine the teachings of the references. *See id.* In the present case, the Examiner has not provided any reason why one of ordinary skill in the art aware of the acoustic panels of Hom or Mnich et al. would be motivated to look to the ice protection system of Dean et al.

Moreover, it is respectfully submitted that the Examiner's assertion that Dean et al. teaches an ice protection system having an acoustically permeable structure is incorrect. Fig. 2 of Dean et al. is directed to an aircraft wing having an ice protection system. In Figure 2, an adhesive layer (11) is applied to the wing skin (10), a metal foil sheet (12) is applied to the skin

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(10), and a metal foil sheet (12) is applied to the adhesive layer (11). An insulating layer (13) is applied to the sheet (12) and a metallic layer (14) is applied to the outer surface of the insulating layer (13). Insulating material (15) is applied to the metallic layer (14), and a paint layer (16) is applied to the insulating layer (15). See Dean et al., Fig. 2 and col. 1, line 60-col. 2, line 21. None of these layers are acoustically permeable.

Accordingly, even assuming *arguendo* that one of ordinary skill in the art would be motivated to combine the acoustic panels of Horn or Mnich et al. with the ice protection system of Dean et al., there is no teaching or suggestion that the multi-layered structure of Dean et al. could successfully be employed on an acoustically permeable structure. In fact, such a combination would impermissibly change the basic principle of operation of Dean et al., which is the use of its multi-layered ice protection system on a solid surface such as wing skin (10). See MPEP § 2143.01 at p. 2100-132 (Rev. 2, May 2004) (citation omitted) (the teachings of the references are insufficient to render claims *prima facie* obvious when the proposed modification or combination of the references would change the principle of operation of the prior art invention being modified). In view of the failure of the teachings of the cited prior art to suggest the combination of Horn or Mnich et al. with Dean et al., it is respectfully submitted that the Examiner is impermissibly employing hindsight to combine the acoustic panels of Horn or Mnich et al. and the ice protection system of Dean et al. See, e.g., *In re Skoll*, 187 USPQ 481 (CCPA 1975) (the prior art references, viewed by themselves and not in retrospect, must suggest doing what the applicant has done). See also MPEP § 2141.01 at p. 2100-121 (Rev. 2, May 2004) (the requirement of Section 103 that the invention be obvious "at the time the invention was made" is to avoid impermissible hindsight). Accordingly, it is respectfully submitted that

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Claims 1 and 16, as well as the remaining claims ultimately dependent thereon, are nonobvious and patentable over Hom or Mnich et al. in combination with Dean et al.

Claims 10-13 have been rejected under 35 U.S.C. 103 as obvious in view of Hom or Mnich et al. as modified by Dean et al., and further in view of U.S. Patent No. 4,514,619 (Kugelman et al.) or U.S. Patent No. 4,036,457 (Volkner et al.). However, as set forth above, it is respectfully submitted that Claim 1 is nonobvious and patentable over Hom or Mnich et al. in combination with Dean et al. Accordingly, it is respectfully submitted that Claims 10-13 (which are all ultimately dependent on Claim 1) are nonobvious and patentable in view of Hom or Mnich et al. as modified by Dean et al., and further in view of Kugelman et al., or Volkner et al.

Conclusion

Based on the foregoing amendments and remarks, favorable consideration and allowance of all of the claims now present in the application are respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

The Commissioner is authorized to charge any required fees, including any extension and/or excess claim fees, any additional fees, or credit any overpayment, to Goodwin Procter LLP Deposit Account No. 06-0923.

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Respectfully submitted for Applicant,



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